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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,404	09/24/2003	Viacheslav A. Petrov	UC0318 US NA	5035

23906 7590 03/15/2006

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/669,404

Applicant(s)

PETROV, VIACHESLAV A.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2006 and 01 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Status of Claims***

1. Claims 1-8 are pending.  
Claims 1-8 are rejected.  
Claim 9 is canceled.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 24, 2006 has been entered.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanechika et al. (US 5,547,593) in view of JP 02227285 A).

Sanechika et al. disclose a lubricant oil composition comprising a compound (A), having the claimed compound structure and a compound (B), which the Examiner considers to be equivalent to the applicants claimed organic active material (see entire disclosure, in particular column 4, line 33 to column 5, line 64; column 35, line 34 to column 38, line 23; column 43, line 6 to column 44, line 41; compounds S4, S8, S12 and S13 in columns 55, 57 and 58; examples 17-20 in column 67 and Table 5 ;

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and example 29 in column 69 and 70). Styrene oligomer is an example of compound (B). JP 02227285

A teaches that styrene oligomer is a buffer layer material (see Derwent abstract).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poetsch et al. (US 5,348,677).

Poetsch et al. teach compounds having a formula I, which have the same structural formula as the claimed compound structure (see entire disclosure, in particular column 3, lines 23-66; column 6, line 31 to column 8, line 62; column 9, lines 26-34 and column 17, lines 25-35). Poetsch et al. teach electro-optical liquid crystal display elements containing their formula I compounds (see column 1, line 7 to column 2, line 28).

Poetsch et al. fail to expressly disclose the claimed organic active materials however their use is clearly suggested (see column 16, lines 23-40).

One having ordinary skill in the art at the time the invention was made would have found it obvious to combine the claimed organic active materials with the fluorine containing compounds of Poetsch et al. for use in liquid crystal display elements, since Poetsch et al. teach that their liquid-crystalline dielectrics can be modified by suitable additives in a such a way that they can be used in all of the disclosed types of liquid crystal display elements (see column 16, lines 23-26).

Poetsch et al. fail to expressly disclose the compounds of claim 6. However, Poetsch et al. suggest the compounds of claim 6 and the compounds expressly disclosed in example 1 of Poetsch et

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al. have close structural similarity and similar utility as the compounds of claim 6. Thus, the compounds of claim 6 are prima facie obvious over the compounds disclosed by Poetsch et al.

### ***Double Patenting***

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1-4 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of copending Application No. 10/669,403. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Response to Amendment***

#### **Claim Rejections - 35 USC § 102**

10. The rejection of claim 6 under 35 U.S.C. 102(b) as being anticipated by Kamal et al. (Tetrahedron Letters, Vol 43, No. 41, August 2002, pp. 7353-7355) is withdrawn, since the compound 1-ethoxy-4-(1,1,2,2-tetrafluoroethoxy)benzene has been deleted from the claim.

11. The rejection of claims 7 and 8 under 35 U.S.C. 102(b) as being anticipated by Yasushi et al. (Patent abstracts of Japan, publication number 06-293691), is withdrawn since in the amendment filed December 1, 2005 the compound disclosed in claim 7 must now have the substituent R, which is not taught or fairly suggested by Yasushi et al.

#### **Claim Rejections - 35 USC § 103**

12. The rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Farbwerke Hoechst A. G. (GB 1230932), is withdrawn due to the deletion of the compound o-sec-butyl-phenol- $\alpha,\alpha,\beta,\beta$ -tetrafluoroethyl ether in the amendment filed December 1, 2005.

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Double Patenting

The provisional rejection of claims 5 and 9 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/669,403 is withdrawn due to the terminal disclaimer, filed December 1, 2005.

**Response to Arguments**

Rejection of claims 1-5 under 35 U.S.C. 102(b) as being anticipated by Sanechika et al. (US 5,547,593)

13. Applicant's arguments filed December 1, 2005 have been fully considered but they are not persuasive.

The Applicants argue that there is no teaching or suggestion in Sanechika of a solution comprising an organic active material selected from fluorescent emitters, phosphorescent emitters, charge transport materials and buffer layer materials and the specifically recited compounds, as recited in Applicants Claim 1, as amended.

The Examiner disagrees. Compound (B) as taught by Sanechika et al. includes at least one compound, which falls within the Applicants, claimed organic active material. For example Sanechika et al. teach styrene oligomer (see column 35, lines 10-16). Styrene oligomer is a known buffer layer material (see Derwent abstract of JP 02227285 A).

For the above reason this rejection is maintained.

Provisional Rejection of claims 1-4 under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of copending Application No. 10/669,403

14. Applicant's arguments filed December 1, 2005 have been fully considered but they are not persuasive because when m is 1-5 the substituent R is the same in the instant claim 1 as it is in claim 15 of copending Application No. 10/669,403. Further, when R<sub>f</sub> is a C2-C3 fluorinated alkyl the solution of the instant claim 1 is the same as the composition of claim 15 in copending Application No. 10/669,403.

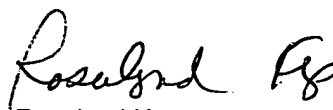
For the above reason this rejection is maintained.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M-W & F 4-10pm; H 5:30am-5pm; Sat 8am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalynd Keys  
Primary Examiner  
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March 5, 2006